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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,828	10/12/2000	James Paschal McCloskey	MSX 302R1	9910
7590 12/01/2004			EXAMINER	
Kolisch Hartwell Dickinson McCormack & Heuser 520 S W Yamhill Street Suite 200 Portland, OR 97204			RODRIGUEZ, JOSEPH C	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/687,828

Applicant(s)

MCCLOSKEY, JAMES PASCHAL

Examiner

Joseph C Rodriguez

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 and 52 is/are allowed.
- 6) ☒ Claim(s) 23,24,26-31,33-44 and 46-51 is/are rejected.
- 7) ☒ Claim(s) 25,32 and 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) \_\_\_\_\_
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152) \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

***Final Rejection***

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Applicant's arguments filed 10/21/04 have been fully considered but they are not persuasive for reasons detailed below.

The prior art rejections are maintained or modified as follows:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 24, 26-31, 33-44 and 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuhmonen in view of Jenkins et al. ("Jenkins")(GB 2200613 A).

Kuhmonen teaches an apparatus (Fig. 1-6 and 14) comprising a chassis (near 12), a trommel (20), input means (19), output means (near collection chute 22 and 24, 120) and a pivotable stockpiling conveyor (26; col. 3, ln. 15 et seq.).

Kuhmonen as set forth above thus teaches all that is claimed except for expressly teaching a two-part conveyor with a second part pivotally attached to the first part, wherein said second part pivots about a perpendicular horizontal axis and wherein said parts extend between a position upwardly and outwardly from the chassis and a retracted position for not extending substantially beyond the chassis. Jenkins (Fig 1-3, multiple embodiments) teaches that this type of pivotable, extendable conveyor system is well known by teaching a first (near 1, 8 before pivot point) connected to a pivotable

second (6) conveyor (Fig. 2, 3). Moreover, Jenkins teaches that this type of conveyor feature allows for space savings by storing the conveyor in a retracted vertical position when not in operation (p. 1). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Kuhmonen with the pivotable second conveyor section taught by Jenkins to achieve space savings during storage.

### ***Response to Arguments***

Applicant's argument that Jenkins is nonanalogous art is unpersuasive. Here, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the instant case, Applicant's invention focuses more on conveyor storage and transportation than on the trommel feature of the claims. That is, the prior art teaches that a portable conveyor and trommel combination are well known and that the essence of the invention, as further demonstrated by the instant arguments, focuses on the portable and retractable conveyor feature. Consequently, as the Jenkins reference can be regarded as reasonably pertinent to the particular problem as this reference focuses on the storage of a conveyor in a retracted position, Applicant's argument is unpersuasive.

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Applicant's argument that the prior art combination of Kuhmonen in view of

Jenkins fails to teach the claimed limitations are also unpersuasive. Here, it is noted that the base reference already teaches a stockpiling conveyor that is both pivotally attached and transportable (Fig. 1, conveyor 26 near pivot point 130), thus there is no need to find these teachings in the secondary reference. Further, Examiner concurs with Applicant's reasoning that Jenkins fails to teach a conveyor folded or pivoted in the manner taught in claim 1 (i.e., over the chassis) and has now indicated this claim set as allowable. However, the subsequent claim sets contain broader versions of a pivotable conveyor feature, wherein the pivotable conveyor is merely claimed as "extending beyond the chassis" (claim 23), having a stowed condition that "tends to minimize its gravitational projection" (claim 26), or having a stowed condition extending "generally upwardly from the chassis" (claim 41) and Jenkins teaches these broader versions. That is, Jenkins expressly teaches using a second pivotable conveyor portion that provides space savings by allowing the conveyor to be stored in an upright position (p. 1), thus one has motivation to modify the stockpiling conveyor of Kuhmonen with a second pivotable portion. This modified conveyor anticipates the broader versions of the claimed pivotable conveyor and undermines Applicant's arguments that Jenkins is not pertinent, does not teach the various "stowed" positions in the broader claims sets, or that the motivation is derived from Applicant's disclosure. Therefore, as Applicant's arguments are unpersuasive in view of the prior art, the claims stand rejected.

Applicant's argument that the prior art combination of Kuhmonen in view of  
Jenkins fails to teach a conveyor system for transportation from one location to another

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is also misplaced. Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the prior art combination is certainly capable of transportation as Kuhmonen already teaches a transportable conveyor system. Jenkins is simply relied on for the concept of a pivotable conveyor that allows easier storage of the conveyor, thus it is unclear how, as Applicant now argues, this modified conveyor cannot be transported.

#### ***Allowable Subject Matter***

Claim 1-22 and 52 are allowed:

Claims 25, 32 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Claim Objections***

Claims 1-52 are objected to under 37 CFR 1.173, as being of improper form. Applicant is required to cancel the claims, or amend the claims to place the claims in proper form.

Here, the claims presented in the amendment of 10/12/04 are not in compliance with 37 CFR 1.173. In accordance with 37 CFR 1.173(b)(2) and (d), any changes to the specification, including the claims, must include specific markings in the submitted

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version of the claims. In particular, Applicant is advised to focus on the sections regarding *how re-issue claims with added matter are to presented*. Further, if the original claims are unamended, they should be reinstated and not represented.

Further, in accordance with 37 CFR 1.173(c), an "explanation of the support in the disclosure" must be indicated for all changes, including all features of all new claims.

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,819,950 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Further, in accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed if Applicant chooses to make amendments to the application. That is, an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1), that also encompasses the amendments, that contains a statement that all amendments made since the filing of the reissue were made without any deceptive intention on the

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part of the applicant (see 37 CFR 1.175 and MPEP § 1414) would overcome a rejection under 35 U.S.C. 251.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is **703-306-2571** or **703-308-6552**.

The examiner's **UNOFFICIAL Personal fax number** is **703-746-3678**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

**<http://pair-direct.uspto.gov>**

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **703-308-1113**.

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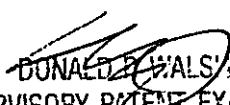
Signed by Examiner Joseph Rodriguez



jcr

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November 29, 2004



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